

Docket No. 24180-124-004

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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GROUP 3600

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In Re U.S. Patent Application of:

Applicant: CURIE *et al.*

Serial No.: 09/901,427

Filed: July 9, 2001

For: **TRANSPARENT MULTILAYER
POLYPROPYLENE CONTAINER
WITH BARRIER PROTECTION**

)
) Art Unit: 3627
)
) Examiner: R. Dye
)

Certificate of Mailing

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)

Matthew E. Leno, Reg. No. 41,149

RESPONSE TO RESTRICTION REQUIREMENT UNDER 37 C.R.F. §1.143

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

This paper is in response to the Office Action mailed November 24, 2003, requiring a restriction election under 35 U.S.C. §121.

The Office Action indicates that pending claims 1-3, 5-19, 21-35, 37-51, 53-67, 69-84 and 86-153, comprise the following distinct inventions:

- I. Claims 1-3, 5-19, 21-35, 37-51, 53-67, 69-84 and 86-98, drawn to containers, classified in class 428, subclass 35.7; and
- II. Claims 99-153, drawn to methods of making containers, classified in class 264, subclass 500.

The Office Action acknowledges that a different Examiner indicated that claims 99-153 were allowable, but takes the position that the examination of 153 different claims would be cumbersome due to species in the present claims and the Information Disclosure Statement filed on July 14, 2003.

T R A V E R S A L

Applicants traverse the outstanding restriction requirement on the following grounds. First, the requirement erroneously states that claims 99-153 are drawn to a method of making a container. Not all of them are. Claims 127-153 are drawn to containers. The preamble of independent claims 127 and 141 (the only independent claims of claims 127-153) both recite "A multilayer container comprising:." Applicants believe that the inclusion of claims 127-153 in claim group II rather than claim group I was in error since the requirement distinguishes claim groups I and II as "process of making and product made," but claims 127-153 clearly belong in 'product made' category rather than the 'process of making' category. If this belief is erroneous, Applicants respectfully request an indication of why claims 127-153 are considered method claims.

Applicants' second ground of traversal lies in the fact that the vast majority of the references cited in the Information Disclosure Statement filed July 14, 2003, had been cited in the parent of the instant application. The only stated reason for levying the requirement is the burden of reviewing the claims in light of the July 14, 2003, Information Disclosure Statement. However, nearly all of the references cited in that Information Disclosure Statement were previously cited in parent patent application serial no. ⁰⁹/293,401 filed April 16, 1999, and were thus available to the Office for review and inspection in conjunction with these very claims prior to the June 11, 2003, Notice Of Allowance.

Pursuant to M.P.E.P. §609, it is presumed the Office reviewed that majority of references cited to the Office in parent patent application serial no. ⁰⁹/293,401. M.P.E.P. §609 states, in part, that "[t]he examiner will consider information which has been considered by the Office in a parent application when examining (A) a continuation application filed under 37 C.F.R. §1.53(b) or filed

under former 37 C.F.R. §1.60....” The vast majority of the references cited in the Information Disclosure Statement filed on July 14, 2003, were disclosed to the Office in Information Disclosure Statements filed in parent patent application serial no. ⁰⁹/293,401 on July 21, 1999, June 20, 2000, and June 12, 2002. Other references were made of record by the Office in that application.

PROVISIONAL ELECTION

In compliance with 37 C.F.R. § 1.143, Applicants provisionally elect to prosecute claim group I which the requirement indicates as including claims 1-3, 5-19, 21-35, 37-51, 53-67, 69-84 and 86-98, but should also include claims 127-153 for the reasons addressed above. Applicants' election is not to be construed as an admission that Applicants believe any claim set forth in the above-identified application is obvious over any other claim set forth in the above-identified application. Applicants reserve the right to prosecute the non-elected claims in divisional or other continuation applications.

CONCLUSION

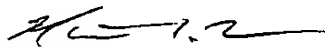
Applicants asserts that this application is in condition for allowance. Early action to that end is requested.

Respectfully submitted,

McDERMOTT, WILL & EMERY

Date: December 9, 2003

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